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Date: March 17, 2008

Signed:


Peter K. Trzyna (Reg. No. 32,601)

PATENT

Paper No.

File: Contcir-P1-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : McDermott, Brian J.; McGowen, Daniel; Spotts, Ralph Leo Jr.; Tryzbiak, Sid

Serial No. : 10/790,363

Filed : March 1, 2004

For : ELECTRICAL DEVICE WITH TEETH JOINING LAYERS AND METHOD FOR MAKING THE SAME

Group Art Unit : 2841

Examiner : Dinh, Tuan T

MS: PETITIONS
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION OF RESTRICTION REQUIREMENT

SIR :

In the above-referenced patent application, Applicant responded to a restriction requirement August 24, 2006, as follows:

...Applicant confirms that an election was made with traverse for Group 1. More particularly, the restriction requirement is believed to be improper, and reconsideration is requested.

First, pursuant to 35 U.S.C. Sec. 132, if the restriction is maintained, Applicant respectfully requests PTO compliance with 35 U.S.C. Sec. 132, i.e., "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". The Examiner contends in the restriction requirement that "Invention I can be made by a subtraction methods such as etching away a blank to form a conductive layer instead of the step of building up the conductive layer." Applicant neither admits nor denies the contention, but requires that degree of proof of the fact that is the Examiner's burden to provide, e.g., pursuant to Sec. 132. Failing *any* proof of the factual basis for the Examiner's contention in the restriction requirement, the restriction requirement is improper.

Second, the restriction requirement is improper because Examiner has not shown that claims are independent and distinct and have separate utility. See, e.g., MPEP Sec. 802.

Third, even if they can be shown to be separate and distinct, there is "a serious burden on the Examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02)." And pursuant to GUIDELINES found there, "examiners must provide reasons and/or examples to support conclusions." The Examiner has not provided sufficient any "reasons and/or examples to support conclusions" as required by the MPEP.

The Sec. 132 information and reasons, the MPEP "reasons and/or examples to support conclusions," and reconsideration are therefore respectfully requested. In the absence thereof, the restriction requirement is improper.

The subsequent Office Action failed to respond.

Applicant is entitled to an explanation as to how "Invention I can be made by a subtraction methods such as etching away a blank to form a conductive layer instead of the step of building up the conductive layer." Applicant is further entitled to a response to that which is set out above. Absent a factual basis for the restriction requirement, the restriction is improper pursuant to 35 U.S.C. §132.

Further, see the Declaration of Professor C.P Wong. Claims drawn to apparatus are believed to be patentable over the cited art, and a rejoinder of the process claims to the apparatus claims is appropriate for this reason too.

APPLICANT CLAIMS LARGE ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235. Additionally, the Examiner is invited to contact the undersigned at (312) 240-0824 if it can in any way expedite or ease the handling of this case.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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Date: March 17, 2008

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